Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT D. FARRIS

Appeal No. 2002-1422
Application No. 08/753,197

ON BRIEF

Before HAIRSTON, DIXON, and BARRY, *Administrative Patent Judges*.
BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

A patent examiner rejected claims 1, 2, 5-10, and 31-40. The appellant appeals therefrom under 35 U.S.C. § 134(a). We reverse.

BACKGROUND

The appellant's invention concerns telephonic voice communication over the Internet. A caller selects Internet routing by dialing a predetermined Internet prefix (e.g., "*82") followed by a destination's telephone number. (Spec. at 14.) The invention then provides directory assistance and call completion services to such caller. The appellant asserts that these services are provided in a way that is

"transparent" to the caller. (Appeal Br. at 2.) In other words, he explains, a caller who has requested an Internet voice telephone connection may receive directory assistance and call completion services in apparently the accustomed manner for access of the services from a public switched telephone network. (*Id.*)

A further understanding of the invention can be achieved by reading the following claim:

> 1. A system for providing a directory assistance call completion service to a terminal, comprising:
>
> a public switched telephone network (PSTN) communications switching system providing switched communication services to said terminal;
>
> a directory assistance service system including a storage of directory listings; and
>
> a public packet data internetwork connected between the PSTN and the directory assistance service system, said internetwork comprising at least a portion of the Internet,
>
> wherein in response to dialing of a directory assistance number on said terminal, said PSTN (i) provides data identifying said terminal to said directory assistance service system via the Internet, and (ii) establishes a two-way communication link between said terminal and said directory assistance service system via the Internet; and
>
> wherein the directory assistance service system provides two-way voice communication between said terminal and said directory assistance service system via said communication link to (i) receive information from said terminal identifying a station with which said terminal seeks to establish a communications link through the Internet, and (ii) provide to said terminal a directory number for said station.

Claims 1, 2, 5-29, and 31-40 stand rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 4,959,855 ("Daudelin") in view of U.S. Patent No. 5,608,786 ("Gordon").

OPINION

Rather than reiterate the positions of the examiner or appellant *in toto*, we address the main point of contention therebetween. Admitting "that Daudelin does not teach a public packet data internetwork that comprises a portion of the Internet and is connected between the PSTN and the directory assistance system," (Examiner's Answer at 4), the examiner makes the following assertion.

> [I]t would have been obvious . . . to apply Gordon's teaching in Daudelin's system to use the Internet and access nodes in place of the voice and data switching network 12 to connect the originating telephone network (represented by local switch 30) to the destination telephone network (represented by local switch 32) and to the directory assistance system 56 with the motivation being to reduce cost and expand system reachability [sic].

(*Id.* at 5-6.) The appellant argues, "[t]here is no explanation given in the Examiner's Answer of why the proposed modification of Daudelin's disclosed solution to this problem, by somehow providing an Internet link, would have resulted in cost savings." (Reply Br. at 4.)

"[T]o establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability

of making the specific combination that was made by the applicants." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000) (citing *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)). "[T]he factual inquiry whether to combine references must be thorough and searching." *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001). "This factual question . . . [cannot] be resolved on subjective belief and unknown authority." *In re Lee*, 277 F.3d 1338, 1343-44, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002). "It must be based on objective evidence of record." *Id.* at 1343, 61 USPQ2d at 1434.

Here, the examiner fails to show objective evidence of the desirability of replacing Daudelin's "Voice and Data Switching Network," Fig. 1, no. 12, with Gordon's "Global Internet System," Fig. 5, no. 4, and "Access Node[s]." *Id.* at no. 6. Although the latter reference does disclose that its "UniPost system . . . for providing a direct telephone link using the data transmission network involving Internet," col. 8, ll. 62-64, "can thus provide [a] subscriber with a further cost advantage in completing his international communications or other long distance communications," col. 9, ll. 2-4, the examiner proffers no evidence that Gordon's UniPost system would provide such a cost advantage when used to connect Daudelin's "calling terminal 40," col. 3, l. 67, with the latter's "directory assistance computer (DAS/C) 56. . . ." Col. 4, ll. 23-24. More specifically, the examiner fails to show that connecting Daudelin's calling terminal 40

and DAS/C 56 would have required international or other long distance communication so as to benefit from Gordon's cost advantage. To the contrary, Daudelin discloses that its "directory assistance service for local and remote numbers is provided from a local source. . . ." Col. 5, ll. 17-18.

Furthermore, we do not understand the examiner's assertion that his proposed replacement would "expand system reachability [sic]." (Examiner's Answer at 6.) Regardless, such "[b]road conclusory statements . . . are not 'evidence.'" *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999)(citing *McElmurry v. Arkansas Power & Light Co.*, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993); *In re Sichert*, 566 F.2d 1154, 1164, 196 USPQ 209, 217 (CCPA 1977)). Therefore, we reverse the rejection of claims 1, 2, 5-29, and 31-40.

CONCLUSION

In summary, the rejection of claims 1, 2, 5-29, and 31-40 under § 103(a) is reversed.

REVERSED

KENNETH W. HAIRSTON Administrative Patent Judge	)
JOSEPH L. DIXON Administrative Patent Judge	) BOARD OF PATENT) APPEALS) AND) INTERFERENCES
LANCE LEONARD BARRY Administrative Patent Judge	)

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